

RESPONSE UNDER 37 C.F.R. § 1.116
U.S. APPLN. NO.: 09/899,817

ATTORNEY DOCKET NO. Q63877

103(a) as being unpatentable over Suzuki and Yamamoto and further in view of Nishida (USP 5,886,774). Claims 3 and 4 have been deemed to contain allowable subject matter and would be allowed if rewritten in independent form. Applicant submits the following in traversal of the rejections.

***Rejection of claims 1, 2, 5-12 and 15-19 under § 103(a) as
being unpatentable over Suzuki and Yamamoto***

As a preliminary matter, Applicant brings to the Examiner's attention that claims 18 and 19 were not rejected over Suzuki and Yamamoto, but over Suzuki and Yamamoto in view of Takaoka.

Claim 1

The Examiner states Yamamoto discloses a database storing the inputted original identifying information in relation to the image file as described in claim 1, citing col. 3, lines 38-51 of Yamamoto in support. It appears the Examiner is referring to a second storing means for teaching the database of claim 1. This is contrary to the Examiner's argument in paragraph 3 of the Office Action in which collating means 6 was cited for teaching a database.

The Examiner states that the stored information includes an index print information and order information corresponding to the index print information and that these two information *certainly may be* used as the identifying information in relation to an image file. The Examiner's assumption on the use of the storage devices at col. 3 of Yamamoto is mere speculation and does not support the rejection. The cited portion only generally describes the presence of certain memory features. The memories are used only to collate an order with an index print by a matching number. In particular, referring to Yamamoto col. 12, lines 20-38, the first and second

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memory merely store an order number (e.g. x) for prints to be collated with an order number (e.g. x) for an index print. When the stored numbers (x-x) correspond, photos and index prints become collated. This detailed description is a more supportable reading of the general description at col. 3. There is no teaching of an image file being stored to a database in relation to original identifying information. The general teachings now cited by the Examiner are replete with ambiguity that cannot support the rejection.

Moreover, the collating means 6 shown in Fig. 1 of Yamamoto merely collates the bar code information printed on an index print with the bar code information on a DP bag. When the bar code information of the index print coincides with that of the DP bag, the index print is sent to a predetermined position. See Yamamoto column 9, lines 22-46. Therefore, the bar code information (image identifying information) is not stored in relation to image data.

Assuming the second storage means is a database as required in claim 1, the second storage means stores in memory the order information as corresponding index print information. Col. 3, lines 40-42. Applicant submits that the Examiner cited Barcode B and items 211-216 of Fig. 16 for teaching the inputted original identifying information. See Office Action para. 3, page 3. The index print information and order information corresponding to the index print information are not the barcode B and items 211-216 of Fig. 16 (see col. 8, lines 15-24 and col. 19, line 65 to col. 20, line 2) initially cited for teaching the inputted original identifying information. Since the Examiner has not established all of the elements of the claims and the interrelationships between the elements, claim 1 and its dependent claims should be deemed patentable.

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Claim 15

Claim 15 requires that the original data is from a digital camera. The Examiner states that although two of the cited references do not explicitly disclose an original image taken by a digital camera, that it would be obvious to an artisan of ordinary skill in the art to consider employing a digital camera for capturing an original image. Particularly, the Examiner states that since a scanner is disclosed in the cited references, incorporating an image captured by a digital camera in place of scanned image would be an obvious substitution since a scanner comprises a CCD to capture or read an image, and a digital camera also uses a CCD for the same purpose. Furthermore, Takaoka teaches various photographing devices including a digital camera.

Applicant submits that the references cited by the Examiner do not explicitly disclose that the original is data from a digital camera. The Examiner's reasoning is merely a result of hindsight upon viewing the Applicant's invention. If either Suzuki or Yamamoto had the capabilities of receiving original data from a digital camera, it would seem that the references would have disclosed those features.

Furthermore, Takaoka was never cited for teaching the elements of claim 15. If the Examiner would now like to cite Takaoka for teaching the features of claim 15, the finality of the present Office Action should be withdrawn.

For the above reasons, claim 15 should be deemed patentable.

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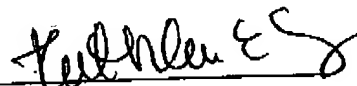
Claims 18-19

Assuming *arguendo* that the photoprinter 10 is connectable to a LAN, this does not necessitate the accessibility of certain databases to multiple laboratories. The Examiner has not established a case of obviousness.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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